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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,553	06/28/2001	Mark Lewis	P 279171 P11166	5111
59796 7590 03/12/2009 INTEL CORPORATION c/o CPA Global P.O. BOX 52050 MINNEAPOLIS, MN 55402				
EXAMINER				
PHILIPPE, GIMS S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/892,553

**Applicant(s)**

LEWIS, MARK

**Examiner**

Gims S. Philippe

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In view of the Appeal brief filed on December 10<sup>th</sup>, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Mehrdad Dastouri/

Supervisory Patent Examiner, Art Unit 2621

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-37 are rejected under 35 U.S.C. 101 as not falling within one of the four categories of inventions.

With respect to claims 1 and 31, Supreme Court precedent and recent Federal Circuit decision indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transform underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process.

For example in claim 1, the method for **location-based image sharing** including steps of defining and applying, is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

The applicant has provided no explicit and deliberate definition of "defining", and "applying" to limit the steps of determining the one or more recipients with whom the image should be shared.

In claim 31, the method for **location-based image sharing** including steps of determining and making, is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

The applicant has provided no explicit and deliberate definition of "determining" and "making" to limit the steps of encoding the new wavelet transform coefficients.

As per claim 9, the system for **location-based image sharing** including the steps of sharing rule defining one or more recipients and sharing engine to apply location identifying information is performed with a software as described in the Specification pages 4-5, paragraph [0014], however, the claimed limitations must be incorporated in a computer readable medium in order for the claims to satisfy the statutory process. The claims do not tie the sharing with any physical device or apparatus.

Claims 2-8, 10-16 and 32-37 are rejected by dependency to claims 1, 9, and 31.

4. The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a

computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

5. Claims 17-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 17 and 25 define a computer program with descriptive material. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") when embodied on a tangible computer readable medium, a signal, carrier wave, etc. embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101.

With respect to claims 7 and 25, the Specification paragraph [0032], lines 10-13, qualifies a **carrier wave modulated** as the "medium" for carrying the signal. In addition, paragraph [025], qualifies any other medium as being usable to carry the program. Considering the embodiments disclosed in the specification, the medium referred to in the claims is non-statutory.

Note: The applicant is urged to review the application in order to avoid non-statutory medium such as "a **carrier wave** or the **Internet**".

Claims 18-24 and 26-30 are rejected by dependency to claims 17 and 25.

***Response to Arguments***

6. The applicant argues that the examiner has misunderstood the scope of the claimed invention, as well as the teachings of Albanese et al. The applicant notes that the location-identifying information, as described and claimed, is information associated with the subject location. This is not the location of the actual electronic image, file folder, or where the image was scanned, but the location of where the image was photographed, or rather the location of the subject of the image, i.e., where the object captured by the image are located.

In response to the above arguments, the examiner reminds the applicant that the scanners 2A, 2B, 2C to 2N as shown in fig. 3 of Sheridan are physically located at different locations as disclosed in Sheridan col. 6, lines 36-63 where each identification signal is unique in that it includes a scanner location identification (See Sheridan col. 6, lines 60-63).

The applicant should also note that the claims are written broadly and, the interpretation is given broadly. There is no specific limitation that would lead one skilled in the art to differentiate between the scanner location of Sheridan and the applicant's claimed location. The claims do not call for any location where only an actual street name and house number would make a difference over the cited prior art.

In addition, the examiner appreciates the explanation provided to the "location-identifying information", however, the examiner did understand what was claimed; and while the applicant may think otherwise, to the examiner, the location where the object/subject was photographed is equivalent to the location where the image was scanned. In order to test the location, the applicant must pose the following question: If there are three images scanned at three different locations by three friends who want to share these three pictures based upon certain sharing rules, does claim 1 meet the need of these three friends? In other words, does it make a difference whether the pictures were taken at three different locations or scanned at the three different locations? To the examiner there is no difference between the scanned location and the photographed location. If the applicant understands the explanation given above, paragraphs [0034] and [0065] of Albanese answer the obvious question as well as the claimed limitations.

The examiner introduced Albanese in order to reinforce the previously cited art. The citation of an additional prior art is only to prove that such limitations are well known. In fact, to the examiner the proposed combination of Sheridan and Stewart provides the "location-identifying information" (See Stewart col. 5, lines 11-31), as previously noted in the last office action page 4, paragraphs 1 and 2.

The applicant further argues that applicant's claimed invention defines a sharing rule that specifies the recipient based on location-identifying information, where the location-

identifying information is associated with a physical location of subjects and objects captured by the image.

The examiner respectfully disagrees with the applicant's interpretation since the sharing rule was clearly shown in Sheridan col. 4, lines 51-67 and col. 5, lines 1-18. The proposed combination of Stewart, Sheridan and Albanese does provide the rule based on the physical location as claimed.

The applicant's arguments are not persuasive. The rejection is repeated below for the sake of completeness.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheridan (US Patent no. 5760917) in view of Stewart et al. (US Patent no. 6389460), and further in view of Albanese et al. (US Patent Application Publication no. 2006/0167985 A1).

Regarding claims 1, 9, 17, 25 and 31, Sheridan discloses the same method for location-based image sharing (See Abstract), comprising defining a sharing rule associated with the one or more recipients with whom images should be shared based on location-identifying information with the images (See Sheridan Fig. 3, items 2A to 2N, col. 4, lines 51-67, col. 5, lines 1-18 and col. 6, lines 36-63), and applying location identifying information associated with an image to the sharing rule to determine the one or more recipients with which the image should be shared (See Sheridan col. 5, lines 10-18, col. 6, lines 13-32, and lines 56-63).

It is noted that while Sheridan applies location identifying information as previously shown in the last office action (See Sheridan col. 5, lines 10-18, col. 6, lines 13-32, and lines 56-63), it is silent about the location identifying information being associated with a physical location of the image subject as newly claimed.

However, Stewart discloses location identifying information being associated with a physical location of the image subject (See Stewart col. 5, lines 11-31).

Therefore, it is considered obvious that one skilled in the art at the time of the invention would recognize the advantage of modifying Sheridan's step of identifying information by incorporating Stewart's teachings wherein the location identifying information being associated with a physical location of the image subject. The motivation for performing such a modification in Sheridan is to efficiently deliver image to a user as taught by Stewart (See Stewart col. 3, lines 55-58 and col. 4, lines 6-14).

It is noted that although the proposed combination of Sheridan and Stewart discloses location identifying information (See Stewart col. 5, lines 11-31), it is silent

about the physical location of subjects and objects captured by the image as newly specified in the claims.

However, Albanese discloses a location-based sharing rule specifying the physical location of subjects and objects captured by the image (See Albanese paragraph [0034] home nodes 130-N of paragraph [0038]).

Therefore, it is considered obvious that one skilled in the art at the time of the invention would recognize the advantage of modifying the proposed combination of Sheridan and Stewart by incorporating Albanese' step of specifying the physical location of subjects and objects captured by the image. The motivation for performing such a modification in Sheridan and Stewart's combination is to enable a user to view a selected picture, which could be a picture of a location visited by his friend and family or one of his pictures with his family and friends.

As per claims 2, 4, 6, 10, 14, 18, 22, 29, and 35 most of the limitations of these claims have been noted in the above rejection of claims. In addition, Sheridan further makes the image automatically available to the determined recipients and automatically sends the digital image once the requested admission is granted (See Sheridan figs. 2-3, and col. 4, lines 51-67 and col. 5, lines 1-41).

As per claims 5, 7, 12-13, 15, 21, 23, 28, 30, 34, and 36, Sheridan further provides identifying information comprising latitude and longitude coordinates, proximity identifying information, and a set of location-identifying information (See col. 6, lines 60-

66, col. 8, lines 58-67). The applicant should note that the mailing address referred to in Sheridan col. 8, lines 66-67 will provide the proximity information as well as the latitude and longitude coordinates.

As per claim 33, 20, and 27 Sheridan further converts the location identifying-information into location data using a location database (See col. 8, lines 25-34 and lines 58-67).

As per claims 8, 16, 24 and 37, most of the limitations of these claims have been noted in the above rejection of claims 1 and 31. In addition, Sheridan further defines sharing rule wherein images are shared on a buddy list (See Sheridan's buddy list in fig. 2, and col. 4, lines 51-67 and col. 5, lines 1-18).

As per claim 3, 11, 19, 26 and 32, most of the limitations of these claims have been noted in the above rejection of claims 1, 11, 25. In addition, Sheridan further discloses e-mailing a copy of the image or sending a Web link to the recipients (See Sheridan's col. 5, lines 19-42).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S. Philippe whose telephone number is (571) 272-7336. The examiner can normally be reached on M-F (10:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571) 272-7418. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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